IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Noel Enete et al.   Art Unit : 2457
Serial No. : 09/911,799   Examiner : Avi M. Gold
Filed : July 25, 2001   Conf. No. : 4883
Title : VIDEO MESSAGING

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

<u>BRIEF ON APPEAL</u>

(1) Real Party in Interest

AOL LLC, formerly known as America Online, Inc., is the real party in interest.

(2) Related Appeals and Interferences

There are no related appeals or interferences.

(3) Status of Claims

Claims 36-42, 44-50, 52-62, 64-66, and 68-97 presently are pending in the application. Claims 1-35, 43, 51, 63, and 67 have been canceled. Claims 85-87 and 97 have been withdrawn from consideration. Claims 36-42, 44-50, 52-62, 64-66, 68-84, and 88-96 stand rejected.

However, as explained in greater detail below in section "(4) Status of Amendments," appellants expect the claim amendments made in appellants' Amendment of October 7, 2009 to be entered. Assuming that the claim amendments made in appellants' Amendment of October 7, 2009 are entered, claims 1-35, 37-47, 49-55, 57-63, 65-67, 70-81, and 83-97 will be canceled, and only claims 36, 48, 56, 64, 68, 69, and 82, all of which are independent, will be pending. In addition, appellants expect that each of amended independent claims 36, 48, 56, 64, 68, 69, and 82 will remain rejected.

(4) Status of Amendments

On August 18, 2009, appellants filed an after-final Amendment in which appellants amended independent claims 36, 48, 56, 64, 68, 69, and 82 to incorporate previously pending dependent claims 90-96, respectively. On September 22, 2009, the Office issued an Advisory

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Action indicating, among other things, that the claim amendments made in appellants' August 18, 2009 Amendment had not been entered. In particular, the Advisory Action noted that dependent claims remained depending from each of the newly amended independent claims 36, 48, 56, 64, 68, 69, and 82, and that the features recited in the dependent claims in combination with the features newly recited in amended independent claims 36, 48, 56, 64, 68, 69, and 82 raised new issues that would require further consideration and/or search. *See, e.g.,* Advisory Action of September 22, 2009 at Continuation Sheet, lines 1-2.

On October 7, 2009, appellants again filed an after-final Amendment in which appellants amended independent claims 36, 48, 56, 64, 68, 69, and 82 to incorporate previously pending dependent claims 90-96, respectively, and in which appellants canceled all of the remaining dependent claims. The Office has not yet issued any indication of whether the claim amendments made in appellants' October 7, 2009 Amendment have been entered. Nevertheless, given that previously pending dependent claims 90-96 depended from independent claims 36, 48, 56, 64, 68, 69, and 82, respectively, and that no claims remain depending from any of independent claims 36, 48, 56, 64, 68, 69, and 82, the claim amendments made in appellants' Amendment of October 7, 2009 do not raise any new issues, and, therefore, appellants expect these claim amendments to be entered.

Accordingly, for the purposes of the remainder of this Appeal Brief, appellants will treat the claims as if the amendments to the claims made in appellants' Amendment of October 7, 2009 have been entered.

(5)   Summary of Claimed Subject Matter[1]

The following summarizes disclosure related to each independent claim with references to the Application's specification and drawings. The references to the specification and drawings are meant to be exemplary, and not limiting.

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[1] The summary of independent claims 36, 48, 56, 64, 68, 69, and 82 reflects the subject matter recited in independent claims 36, 48, 56, 64, 68, 69, and 82 as amended in appellants' Amendment of October 7, 2009. Alternatively, the summary of these claims reflects the subject matter recited in dependent claims 90-96 prior to appellants' Amendment of October 7, 2009.

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Independent Claim 36 (Previously presented as dependent claim 90)

Independent claim 36 is directed to a communications method. As recited in independent claim 36, a presence-based communications session is established between a sender and a recipient. *See, e.g.*, Application at page 15, line 28 to page 16, line 10; page 17, line 1 to page 19, line 4; and FIG. 6 (elements 606, 608, 610, 612, 614, 616, 618, 620, 622, 624, 626, 628, and 630). Establishing this presence-based communications session between the sender and the recipient includes initiating a text instant messaging session between the sender and the recipient (*see, e.g.*, Application at page 16, lines 11-25; page 17, line 1 to page 19, line 4; and FIG. 6 (elements 606, 608, 610, 612, 614, 616, 618, 620, 622, 624, 626, 628, and 630)), and, in response, enabling display, to the sender, of an instant messaging graphical user interface associated with the initiated text instant messaging session that is configured to enable the sender to compose and send text instant messages to the recipient (*see, e.g.*, Application at page 16, lines 11-25), determining if the recipient is capable of participating in video instant messaging (*see, e.g.*, Application at page 17, line 30 to page 18, line 8; and FIG. 6 (element 618)), and, based on a determination that the recipient is capable of participating in video instant messaging, enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging (*see, e.g.*, Application at page 17, line 30 to page 18, line 27; FIG. 6 (elements 620, 622, and 624); FIG. 7 (element 704); and FIG. 8). During the presence-based communications session between the sender and the recipient, a video communications session is established between the sender and the recipient (*see, e.g.*, Application at page 19, line 5 to page 20, line 5; and FIG. 6 (elements 632, 634, 636, 638, 640, 642, 644, and 646)), a video instant message is generated on behalf of the sender and stored (*see, e.g.*, Application at page 20, line 6 to page 21, line 5; and FIG. 6 (elements 648 and 650)), and, after generation of the video instant message is complete, an indication to trigger sending of the video instant message to the recipient is received (*see, e.g.*, Application at page 21, lines 6-10; page 22, line 4 to page 23, line 5; and FIG. 6 (elements 652 and 658)). Finally, in response to receiving the indication to trigger sending of the video instant message to the recipient, a transfer of the video instant message to the recipient using the video communications session is initiated. *See, e.g.*, Application at page 21, lines 6-10; page 23, lines 6-14; and FIG. 6 (elements 652 and 660).

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Independent claim 48 (Previously presented as dependent claim 91)

Independent claim 48 is directed to a communications method. As recited in independent claim 48, a presence-based communications session is established between a sender and a recipient. *See, e.g.,* Application at page 15, line 28 to page 16, line 10; page 17, line 1 to page 19, line 4; and FIG. 6 (elements 606, 608, 610, 612, 614, 616, 618, 620, 622, 624, 626, 628, and 630). Establishing this presence-based communications session between the sender and the recipient includes initiating a text instant messaging session between the sender and the recipient (*see, e.g.,* Application at page 16, lines 11-25; page 17, line 1 to page 19, line 4; and FIG. 6 (elements 606, 608, 610, 612, 614, 616, 618, 620, 622, 624, 626, 628, and 630)), and, in response, enabling display, to the sender, of an instant messaging graphical user interface associated with the initiated text instant messaging session that is configured to enable the sender to compose and send text instant messages to the recipient (*see, e.g.,* Application at page 16, lines 11-25), determining if the recipient is capable of participating in video instant messaging (*see, e.g.,* Application at page 17, line 30 to page 18, line 8; and FIG. 6 (element 618)), and, based on a determination that the recipient is capable of participating in video instant messaging, enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging (see, e.g., Application at page 17, line 30 to page 18, line 27; FIG. 6 (elements 620, 622, and 624); FIG. 7 (element 704); and FIG. 8). During the presence-based communications session between the sender and the recipient, a video communications session between the sender and the recipient is established (*see, e.g.,* Application at page 19, line 5 to page 20, line 5; and FIG. 6 (elements 632, 634, 636, 638, 640, 642, 644, and 646)), and a completed video instant message sent by the sender using the video communications session is received and stored on behalf of the recipient (*see, e.g.,* Application at page 21, line 16 to page 23, line 22; and FIG. 6 (elements 654, 656, 658, 660, 662, and 664)). In addition, the stored video instant message is accessed and presentation of the video instant message to the recipient is enabled. *See, e.g.,* Application at page 21, line 24 to page 23, line 22; and FIG. 6 (elements 658, 660, 662, and 664).

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Independent claim 56 (Previously presented as dependent claim 92)

Independent claim 56 is directed to a computer program, stored on a computer readable medium. *See, e.g.,* Application at page 2, lines 16-18. As recited in independent claim 56, instructions are stored on the computer readable medium for establishing a presence-based communications session between a sender and a recipient. *See, e.g.,* Application at page 15, line 28 to page 16, line 10; page 17, line 1 to page 19, line 4; and FIG. 6 (elements 606, 608, 610, 612, 614, 616, 618, 620, 622, 624, 626, 628, and 630). These instructions for establishing the presence-based communications session between the sender and the recipient include instructions for initiating a text instant messaging session between the sender and the recipient (*see, e.g.,* Application at page 16, lines 11-25; page 17, line 1 to page 19, line 4; and FIG. 6 (elements 606, 608, 610, 612, 614, 616, 618, 620, 622, 624, 626, 628, and 630)), and, in response, enabling display, to the sender, of an instant messaging graphical user interface associated with the initiated text instant messaging session that is configured to enable the sender to compose and send text instant messages to the recipient (*see, e.g.,* Application at page 16, lines 11-25), determining if the recipient is capable of participating in video instant messaging (see, e.g., Application at page 17, line 30 to page 18, line 8; FIG. 6 (element 618)), and, based on a determination that the recipient is capable of participating in video instant messaging, enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging (*see, e.g.,* Application at page 17, line 30 to page 18, line 27; FIG. 6 (elements 620, 622, and 624); FIG. 7 (element 704); and FIG. 8). In addition, instructions are stored on the computer readable medium for establishing a video communications session between the sender and the recipient (*see, e.g.,* Application at page 19, line 5 to page 20, line 5; and FIG. 6 (elements 632, 634, 636, 638, 640, 642, 644, and 646)) and generating and storing a video instant message on behalf of the sender (*see, e.g.,* Application at page 20, line 6 to page 21, line 5; and FIG. 6 (elements 648 and 650)). Finally, instructions are stored on the computer readable medium for receiving an indication to trigger sending of the video instant message to the recipient (*see, e.g.,* Application at page 21, lines 6-10; page 22, line 4 to page 23, line 5; and FIG. 6 (elements 652 and 658)), and, in response, initiating a transfer of the video instant message to the recipient using the video communications session (*see, e.g.,* Application at page 21, lines 6-10; page 23, lines 6-14; and FIG. 6 (elements 652 and 660)).

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Independent claim 64 (Previously presented as dependent claim 93)

Independent claim 64 is directed to a computer program, stored on a computer readable medium. *See, e.g.,* Application at page 2, lines 16-18. As recited in independent claim 64, instructions are stored on the computer readable medium for establishing a presence-based communications session between a sender and a recipient. *See, e.g.,* Application at page 15, line 28 to page 16, line 10; page 17, line 1 to page 19, line 4; and FIG. 6 (elements 606, 608, 610, 612, 614, 616, 618, 620, 622, 624, 626, 628, and 630). These instructions for establishing the presence-based communications session between the sender and the recipient include instructions for initiating a text instant messaging session between the sender and the recipient (*see, e.g.,* Application at page 16, lines 11-25; page 17, line 1 to page 19, line 4; and FIG. 6 (elements 606, 608, 610, 612, 614, 616, 618, 620, 622, 624, 626, 628, and 630)), and, in response, enabling display, to the sender, of an instant messaging graphical user interface associated with the initiated text instant messaging session that is configured to enable the sender to compose and send text instant messages to the recipient (*see, e.g.,* Application at page 16, lines 11-25), determining if the recipient is capable of participating in video instant messaging (*see, e.g.,* Application at page 16, lines 11-25), and, based on a determination that the recipient is capable of participating in video instant messaging, enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging (*see, e.g.,* Application at page 17, line 30 to page 18, line 27; FIG. 6 (elements 620, 622, and 624); FIG. 7 (element 704); and FIG. 8). In addition, instructions are stored on the computer readable medium for establishing a video communications session between the sender and the recipient (*see, e.g.,* Application at page 19, line 5 to page 20, line 5; and FIG. 6 (elements 632, 634, 636, 638, 640, 642, 644, and 646)) and receiving and storing, on behalf of the recipient, a completed video instant message sent by the sender using the video communications session (*see, e.g.,* Application at page 21, line 16 to page 23, line 22; and FIG. 6 (elements 654, 656, 658, 660, 662, and 664)). Finally, instructions are stored on the computer readable medium for accessing the stored video instant message and enabling presentation of the video instant message to the recipient. *See, e.g.,* Application at page 21, line 24 to page 23, line 22; and FIG. 6 (elements 658, 660, 662, and 664).

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Independent claim 68 (Previously presented dependent claim 94)

Independent claim 68 is directed to a system. As recited in independent claim 68, the system includes means for establishing a presence-based communications session between a sender and a recipient. *See, e.g.,* Application at page 15, line 28 to page 16, line 10; page 17, line 1 to page 19, line 4; and FIG. 6 (elements 606, 608, 610, 612, 614, 616, 618, 620, 622, 624, 626, 628, and 630). The means for establishing a presence-based communications session between the sender and the recipient includes means for initiating a text instant messaging session between a sender and a recipient (*see, e.g.,* Application at page 16, lines 11-25; page 17, line 1 to page 19, line 4; and FIG. 6 (elements 606, 608, 610, 612, 614, 616, 618, 620, 622, 624, 626, 628, and 630)), means for enabling display, to the sender, of an instant messaging graphical user interface associated with the initiated text instant messaging session that is configured to enable the sender to compose and send text instant messages to the recipient (*see, e.g.,* Application at page 16, lines 11-25), means for determining if the recipient is capable of participating in video instant messaging (*see, e.g.,* Application at page 17, line 30 to page 18, line 8; and FIG. 6 (element 618)), and means for enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging based on a determination that the recipient is capable of participating in video instant messaging (*see, e.g.,* Application at page 17, line 30 to page 18, line 27; FIG. 6 (elements 620, 622, and 624); FIG. 7 (element 704); and FIG. 8). The system also includes means for establishing a video communications session between the sender and the recipient (*see, e.g.,* Application at page 19, line 5 to page 20, line 5; and FIG. 6 (elements 632, 634, 636, 638, 640, 642, 644, and 646)), means for generating a video instant message on behalf of the sender (*see, e.g.,* Application at page 20, line 6 to page 21, line 5; and FIG. 6 (elements 648 and 650)), and means for storing the video instant message on behalf of the sender (*see, e.g.,* Application at page 20, line 6 to page 21, line 5; and FIG. 6 (elements 648 and 650)). In addition, the system includes means for receiving an indication to trigger sending of the video instant message to the recipient (*see, e.g.,* Application at page 21, lines 6-10; page 22, line 4 to page 23, line 5; and FIG. 6 (elements 652 and 658)), and means for initiating a transfer of the video instant message to the recipient using the video communications session in response to receiving the indication to

trigger sending of the video instant message to the recipient (*see, e.g.*, Application at page 21, lines 6-10; page 23, lines 6-14; and FIG. 6 (elements 652 and 660)).

Independent claim 69 (Previously presented as dependent claim 95)

Independent claim 69 is directed to a system. As recited in independent claim 69, the system includes means for establishing a presence-based communications session between a sender and a recipient through an instant messaging host. *See, e.g.*, Application at page 15, line 28 to page 16, line 10; page 17, line 1 to page 19, line 4; and FIG. 6 (elements 606, 608, 610, 612, 614, 616, 618, 620, 622, 624, 626, 628, and 630). The means for establishing the presence-based communications session between the sender and the recipient includes means for initiating a text instant messaging session between the sender and the recipient (*see, e.g.*, Application at page 16, lines 11-25; page 17, line 1 to page 19, line 4; and FIG. 6 (elements 606, 608, 610, 612, 614, 616, 618, 620, 622, 624, 626, 628, and 630)), means for enabling display, to the sender, of an instant messaging graphical user interface associated with the initiated text instant messaging session that is configured to enable the sender to compose and send text instant messages to the recipient (*see, e.g.*, Application at page 16, lines 11-25), means for determining if the recipient is capable of participating in video instant messaging (*see, e.g.*, Application at page 17, line 30 to page 18, line 8; FIG. 6 (element 618)), and means for enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging based on a determination that the recipient is capable of participating in video instant messaging (*see, e.g.*, Application at page 17, line 30 to page 18, line 27; FIG. 6 (elements 620, 622, and 624); FIG. 7 (element 704); and FIG. 8). The system also includes means for establishing a video communication session between the sender and the recipient (*see, e.g.*, Application at page 19, line 5 to page 20, line 5; and FIG. 6 (elements 632, 634, 636, 638, 640, 642, 644, and 646)), means for receiving and means for storing a completed video instant message sent by the sender using the video communications session (*see, e.g.*, Application at page 21, line 16 to page 23, line 22; and FIG. 6 (elements 654, 656, 658, 660, 662, and 664)). In addition, the system includes means for accessing the stored video instant message and means for enabling presentation of the video instant message to the recipient during the

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presence-based communications session. *See, e.g.*, Application at page 21, line 24 to page 23, line 22; and FIG. 6 (elements 658, 660, 662, and 664).

Independent claim 82 (Previously presented as dependent claim 96)

Independent claim 82 is directed to a communications method. As recited in independent claim 82, a presence-based communications session is established between a sender and a recipient. *See, e.g.*, Application at page 15, line 28 to page 16, line 10; page 17, line 1 to page 19, line 4; and FIG. 6 (elements 606, 608, 610, 612, 614, 616, 618, 620, 622, 624, 626, 628, and 630). Establishing the presence-based communications session between the sender and the recipient includes initiating a text instant messaging session between a sender and a recipient (*see, e.g.*, Application at page 16, lines 11-25; page 17, line 1 to page 19, line 4; and FIG. 6 (elements 606, 608, 610, 612, 614, 616, 618, 620, 622, 624, 626, 628, and 630)), and, in response, enabling display, to the sender, of an instant messaging graphical user interface associated with the initiated text instant messaging session that is configured to enable the sender to compose and send text instant messages to the recipient (*see, e.g.*, Application at page 16, lines 11-25), determining if the recipient is capable of participating in video instant messaging (*see, e.g.*, Application at page 17, line 30 to page 18, line 8; FIG. 6 (element 618)), and, based on a determination that the recipient is capable of participating in video instant messaging, enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging (*see, e.g.*, Application at page 17, line 30 to page 18, line 27; FIG. 6 (elements 620, 622, and 624); FIG. 7 (element 704); and FIG. 8). During the presence-based communications session and after enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging, a request is received from the sender to establish a video communications session between the sender and the recipient that is concurrent with the presence-based communications session (*see, e.g.*, Application at page 19, lines 5-18; and FIG. 6 (element 634)). In response, a video communications session between the sender and the recipient is established that is concurrent with the presence-based communications session (*see, e.g.*, Application at page 19, line 13 to page 20, line 5; and FIG. 6 (elements 636, 638, 640, 642, 644, and 646)). In addition, during the concurrent presence-based and video communications

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sessions between the sender and the recipient, a video instant message is generated on behalf of the sender (see, e.g., Application at page 20, line 6 to page 21, line 5; and FIG. 6 (elements 648 and 650)), an instruction is received from the sender to send the video instant message to the recipient after generation of the video instant message is complete (see, e.g., Application at page 21, lines 6-10; page 22, line 4 to page 23, line 5; and FIG. 6 (elements 652 and 658)), and, in response, a transfer of the video instant message to the recipient is initiated using the video communications session (see, e.g., Application at page 21, lines 6-10; page 23, lines 6-14; and FIG. 6 (elements 652 and 660)). Finally, a non-video message is received from the sender intended for the recipient (see, e.g., Application at page 16, line 5 to page 18, line 30), and a transmission of the non-video message from the sender to the recipient is initiated using the presence-based communications session (see, e.g., Application at page 16, line 5 to page 18, line 30).

(6)   Grounds of Rejection to be Reviewed on Appeal

The final Office Action of March 18, 2009 rejected previously recited dependent claims 90-96 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,212,548 (DeSimone), U.S. Patent No. 6,748,421 (Ozkan), U.S. Patent No. 7,233,992 (Muldoon), and U.S. Patent No. 6,795,863 (Doty). As discussed above in section "(4) Status of Amendments," on October 7, 2009, appellants filed an after-final Amendment in which appellants amended independent claims 36, 48, 56, 64, 68, 69, and 82. Appellants expect these claim amendments to be entered and for amended claims 36, 48, 56, 64, 68, 69, and 82 to be rejected on the same grounds that the final Office Action of March 18, 2009 rejected previously recited dependent claims 90-96, namely as being unpatentable over DeSimone, Ozkan, Muldoon, and Doty. Accordingly, appellants are appealing the rejection of independent claims 36, 48, 56, 64, 68, 69, and 82 as amended in appellants' Amendment of October 7, 2009 under 35 U.S.C. § 103(a) as being unpatentable over DeSimone, Ozkan, Muldoon, and Doty.

Alternatively, in the event that the claim amendments made in appellants' Amendment of October 7, 2009 are not entered for some reason, appellants are appealing the rejection of dependent claims 90-96 under 35 U.S.C. § 103(a) as being unpatentable over DeSimone, Ozkan, Muldoon, and Doty.

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(7)   **Argument**

The combination of DeSimone, Ozkan, Muldoon, and Doty does not render obvious independent claims 36, 48, 56, 64, 68, 69, and 82 as amended in appellants' Amendment of October 7, 2009 (or dependent claims 90-96 as previously presented prior to appellants' Amendment of October 7, 2009).

As amended, independent claim 36 recites, among other features, determining if a recipient is capable of participating in video instant messaging in response to initiating a text instant messaging session between a sender and the recipient and enabling a graphical user interface displayed to the sender to reflect that the recipient is capable of participating in video instant messaging based on a determination that the recipient is capable of participating in video instant messaging.

The final Office Action acknowledges that DeSimone, Ozkan, and Muldoon fail to describe or suggest these features. Final Office Action of March 18, 2009 at page 16, lines 10-15. Therefore, the final Office Action relies on Doty for teaching these features. In particular, the final Office Action asserts:

> Doty, Jr. teaches the use of a recipient computer specifying its hardware and software capabilities (col. 8, lines 45-50) and a product distribution smart server basing its data stream format on recipient capabilities (col. 8, lines 54-58).

Final Office Action of March 18, 2009 at page 16-18. The Advisory Action of September 22, 2009 expands further upon this position, arguing:

> Doty teaches the ability to determine and indicate if a recipient is capable of participating in specific software; this is shown in column 8, lines 45-63, by the disclosure of a client computer specifying its hardware and software capabilities, which are analyzed by a server.

Advisory Action of September 22, 2009 at continuation Sheet lines 14-16.

Notably, neither the final Office Action nor the Advisory Action of September 22, 2009 contends that Doty describes or suggests determining if a recipient is capable of participating in *video instant messaging*, as recited in independent claim 36. Rather, both the final Office Action and the Advisory Action of September 22, 2009 merely assert that Doty teaches determining

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hardware and software capabilities of a computer, which is insufficient to render obvious the specific feature of determining if a recipient is capable of participating in *video instant messaging*, as recited in independent claim 36. The absence of an argument in either the final Office Action or the Advisory Action of September 22, 2009 that Doty describes or suggests determining if a recipient is capable of participating in *video instant messaging* likely is due to the fact that Doty simply does not describe or suggest determining if a recipient is capable of participating in *video instant messaging*.

Doty teaches a system that streams video to an e-mail recipient using a web-based e-mail application. *See e.g.*, Doty at Abstract. As described by Doty, Doty's system displays the video streamed to the e-mail recipient in the same web page through which the e-mail recipient sends and receives e-mails using the web-based e-mail application. *See e.g.*, Doty at Abstract and FIG. 4. Notably, Doty describes that the video streamed to the e-mail recipient is independent of both (*i*) the e-mail the recipient sends and receives using the web-based e-mail application and (*ii*) the other users with whom the e-mail recipient communicates via e-mail using the web-based e-mail application. *See* Doty at col. 10, lines 33 to col. 12, line 43. Rather, Doty describes that the video streamed to the e-mail recipient is produced and streamed to the e-mail recipient by an organization that is responsible for producing and streaming video to e-mail users, not by other users who have sent e-mails to the e-mail recipient and/or received e-mails from the e-mail recipient. *See* Doty at col. 10, lines 33 to col. 12, line 43.

Doty also teaches that, before video is streamed to the e-mail recipient, Doty's system determines specific capabilities of the e-mail recipient's computer. *See, e.g.*, Doty at col. 8, line 45 to col. 9, line 4. Notably, Doty does not describe that its system determines if the e-mail recipient's computer has general video capability before streaming video to the e-mail recipient. Rather, Doty explicitly indicates that the e-mail recipient's computer is assumed to have general video capability:

> The client recipient computers *38a-38e* each include a video 60 player *39a-39e* that is one of the following types: G2 Real Video, Windows Media, QuickTime 4.0, Q-SIF MPEG-1, or SIF MPEG-1. However, other types of players may be used as necessary.

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Doty at col. 8, lines 58-63. Therefore, because Doty's system assumes that the e-mail recipient's computer has general video capability, there is no need for Doty's system to determine if the e-mail recipient's computer has general video capability before streaming video to the e-mail recipient or otherwise.

The specific capabilities of the e-mail recipient's computer that Doty teaches are determined before video is streamed to the e-mail recipient are the appropriate format and bit-rate for streaming video to the e-mail recipient's computer. *See, e.g.*, Doty at col. 8, line 45 to col. 9, line 4. However, Doty's teaching of determining the appropriate format and bit-rate for streaming video to a computer is irrelevant, because independent claim 36 does not recite determining the appropriate format and bit-rate for streaming video to a computer. Rather, independent claim 36 recites determining if a recipient is capable of participating in *video instant messaging*, and there is no description or suggestion of this feature in Doty.

Furthermore, as discussed above, Doty describes that the video streamed to the e-mail recipient is produced and streamed to the e-mail recipient by an organization that is responsible for producing and streaming video to e-mail users, not by other users who have sent e-mails to the e-mail recipient and/or who have received e-mails from the e-mail recipient. *See* Doty at col. 10, lines 33 to col. 12, line 43. Because Doty describes that the video streamed to the e-mail recipient is produced and streamed to the e-mail user by an organization that is independent from and unrelated to users who have sent e-mails to the e-mail recipient, Doty does not describe or suggest determining if the e-mail recipient is capable of participating in video messaging *in response to initiating a communications session between the e-mail recipient and an e-mail user who has or is going to send an e-mail to the e-mail recipient*. Furthermore, because Doty describes that the video streamed to the e-mail recipient is produced and streamed to the e-mail user by an organization that is independent from and unrelated to users who have sent e-mails to the e-mail recipient and/or who have received e-mails from the e-mail recipient, it is not surprising that Doty does not describe or suggest indicating any of the e-mail recipient's capabilities, let alone the e-mail recipient's capability to engage in video messaging, to an e-mail user who has or is going to send an e-mail to and/or receive an e-mail from the e-mail recipient.

Thus, for at least the foregoing reasons, even when Doty's teachings are combined with those of DeSimone, Ozkan, and Muldoon, the combination does not describe or suggest

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determining if a recipient is capable of participating in video instant messaging in response to initiating a text instant messaging session between a sender and the recipient and enabling a graphical user interface displayed to the sender to reflect that the recipient is capable of participating in video instant messaging based on a determination that the recipient is capable of participating in video instant messaging, as recited in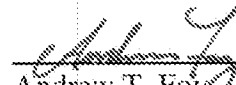 amended independent claim 36. Accordingly, as amended, independent claim 36 is not obvious in view of the combination of DeSimone, Ozkan, Muldoon, and Doty.

As amended in appellants' Amendment of October 7, 2009, each of independent claims 48, 56, 64, 68, 69, and 82 recites features that are similar to those recited in amended independent claim 36 and discussed above. Accordingly, as amended, independent claims 48, 56, 64, 68, 69, and 82 are not obvious in view of the combination of DeSimone, Ozkan, Muldoon, and Doty.

The brief fee of $540 is enclosed. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: November 18, 2009

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Appendix of Claims

1-35. (Canceled)

36. (Previously presented) A communications method, comprising:

establishing a presence-based communications session between a sender and a recipient, wherein establishing the presence-based communications session between the sender and the recipient includes:

initiating a text instant messaging session between the sender and the recipient,

in response to initiating the text instant messaging session between the sender and the recipient, enabling display, to the sender, of an instant messaging graphical user interface associated with the initiated text instant messaging session, the instant messaging graphical user interface being configured to enable the sender to compose and send text instant messages to the recipient,

in response to initiating the text instant messaging session between the sender and the recipient, determining if the recipient is capable of participating in video instant messaging, and

based on a determination that the recipient is capable of participating in video instant messaging, enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging; and

during the presence-based communications session between the sender and the recipient:

establishing a video communications session between the sender and the recipient;

generating a video instant message on behalf of the sender;

storing the video instant message on behalf of the sender;

after generation of the video instant message is complete, receiving an indication to trigger sending of the video instant message to the recipient; and

in response to receiving the indication to trigger sending of the video instant message to the recipient, initiating a transfer of the video instant message to the recipient using the video communications session.

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37-47. (Canceled)

48. (Previously presented) A communications method, comprising:

establishing a presence-based communications session between a sender and a recipient, wherein establishing the presence-based communications session between the sender and the recipient includes:

initiating a text instant messaging session between the sender and the recipient,

in response to initiating the text instant messaging session between the sender and the recipient, enabling display, to the sender, of an instant messaging graphical user interface associated with the initiated text instant messaging session, the instant messaging graphical user interface being configured to enable the sender to compose and send text instant messages to the recipient,

in response to initiating the text instant messaging session between the sender and the recipient, determining if the recipient is capable of participating in video instant messaging, and

based on a determination that the recipient is capable of participating in video instant messaging, enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging; and

during the presence-based communications session between the sender and the recipient:

establishing a video communications session between the sender and the recipient;

receiving, on behalf of the recipient, a completed video instant message sent by the sender using the video communications session;

storing the video instant message on behalf of the recipient;

accessing the stored video instant message; and

enabling presentation of the video instant message to the recipient.

49-55. (Canceled)

56. (Previously presented) A computer program, stored on a computer readable medium, comprising instructions for:

establishing a presence-based communications session between a sender and a recipient, wherein the instructions for establishing the presence-based communications session between the sender and the recipient include instructions for:

initiating a text instant messaging session between the sender and the recipient,

in response to initiating the text instant messaging session between the sender and the recipient, enabling display, to the sender, of an instant messaging graphical user interface associated with the initiated text instant messaging session, the instant messaging graphical user interface being configured to enable the sender to compose and send text instant messages to the recipient,

in response to initiating the text instant messaging session between the sender and the recipient, determining if the recipient is capable of participating in video instant messaging, and

based on a determination that the recipient is capable of participating in video instant messaging, enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging; and

during the presence-based communications session between the sender and the recipient:

establishing a video communications session between the sender and the recipient;

generating a video instant message on behalf of the sender;

storing the video instant message on behalf of the sender; and

after generation of the video instant message is complete, receiving an indication to trigger sending of the video instant message to the recipient; and

in response to receiving the indication to trigger sending of the video instant message to the recipient, initiating a transfer of the video instant message to the recipient using the video communications session.

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57-63. (Canceled)

64. (Previously presented) A computer program, stored on a computer readable medium, comprising instructions for:

establishing a presence-based communications session between a sender and a recipient, the instructions for establishing the presence-based communications session between the sender and the recipient including instructions for:

initiating a text instant messaging session between the sender and the recipient,

in response to initiating the text instant messaging session between the sender and the recipient, enabling display, to the sender, of an instant messaging graphical user interface associated with the initiated text instant messaging session, the instant messaging graphical user interface being configured to enable the sender to compose and send text instant messages to the recipient,

in response to initiating the text instant messaging session between the sender and the recipient, determining if the recipient is capable of participating in video instant messaging, and

based on a determination that the recipient is capable of participating in video instant messaging, enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging; and

during the presence-based communications session between the sender and the recipient:

establishing a video communications session between the sender and the recipient;

receiving, on behalf of the recipient, a completed video instant message sent by the sender using the video communications session;

storing the video instant message on behalf of the recipient;

accessing the stored video instant message; and

enabling presentation of the video instant message to the recipient.

65-67. (Canceled)

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68. (Previously presented) A system comprising:

means for establishing a presence-based communications session between a sender and a recipient, wherein the means for establishing a presence-based communications session between the sender and the recipient includes:

means for initiating a text instant messaging session between a sender and a recipient,

means for enabling display, to the sender, of an instant messaging graphical user interface associated with the initiated text instant messaging session in response to initiating the text instant messaging session between the sender and the recipient, the instant messaging graphical user interface being configured to enable the sender to compose and send text instant messages to the recipient,

means for determining if the recipient is capable of participating in video instant messaging in response to initiating the text instant messaging session between the sender and the recipient, and

means for enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging based on a determination that the recipient is capable of participating in video instant messaging; and

means for establishing, during the presence-based communications session, a video communications session between the sender and the recipient;

means for generating, during the presence-based communications session, a video instant message on behalf of the sender;

means for storing, during the presence-based communications session, the video instant message on behalf of the sender;

means for receiving, during the instant messaging communications session and after generation of the video instant message is complete, an indication to trigger sending of the video instant message to the recipient; and

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means for initiating a transfer of the video instant message to the recipient using the video communications session in response to receiving the indication to trigger sending of the vide instant message to the recipient.

69. (Previously presented) A system comprising:

means for establishing a presence-based communications session between a sender and a recipient through an instant messaging host, wherein the means for establishing the presence-based communications session between the sender and the recipient includes:

means for initiating a text instant messaging session between the sender and the recipient,

means for enabling display, to the sender, of an instant messaging graphical user interface associated with the initiated text instant messaging session in response to initiating the text instant messaging session between the sender and the recipient, the instant messaging graphical user interface being configured to enable the sender to compose and send text instant messages to the recipient,

means for determining if the recipient is capable of participating in video instant messaging in response to initiating the text instant messaging session between the sender and the recipient, and

means for enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging based on a determination that the recipient is capable of participating in video instant messaging;

means for establishing a video communication session between the sender and the recipient;

means for receiving, during the presence-based communications session, a completed video instant message sent by the sender using the video communications session;

means for storing, during the presence-based communications session, the video instant message on behalf of the recipient;

means for accessing, during the presence-based communications session, the stored video instant message; and

means for enabling presentation of the video instant message to the recipient during the
presence-based communications session.

70-81. (Canceled)

82. (Previously presented) A communications method, comprising:

establishing a presence-based communications session between a sender and a recipient,
wherein establishing the presence-based communications session between the sender and the
recipient includes:

initiating a text instant messaging session between a sender and a recipient,

in response to initiating the text instant messaging session between the sender and
the recipient, enabling display, to the sender, of an instant messaging graphical user
interface associated with the initiated text instant messaging session, the instant
messaging graphical user interface being configured to enable the sender to compose and
send text instant messages to the recipient,

in response to initiating the text instant messaging session between the sender and
the recipient, determining if the recipient is capable of participating in video instant
messaging, and

based on a determination that the recipient is capable of participating in video
instant messaging, enabling the graphical user interface associated with the instant
messaging session to reflect that the recipient is capable of participating in video instant
messaging;

during the presence-based communications session, receiving, from the sender, a request
to establish a video communications session between the sender and the recipient that is
concurrent with the presence-based communications session, wherein receiving the request to
establish the video communications session between the sender and the recipient includes
receiving the request to establish the video communications session between the sender and the
recipient after enabling the graphical user interface associated with the instant messaging session
to reflect that the recipient is capable of participating in video instant messaging;

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in response to receiving the request to establish a video communications session between the sender and the recipient, establishing a video communications session between the sender and the recipient that is concurrent with the presence-based communications session; and

during the concurrent presence-based and video communications sessions between the sender and the recipient:

generating a video instant message on behalf of the sender;

receiving an instruction from the sender to send the video instant message to the recipient after generation of the video instant message is complete;

in response to receiving the instruction to send the video instant message to the recipient, initiating a transfer of the video instant message to the recipient using the video communications session;

receiving a non-video message from the sender intended for the recipient; and

initiating a transmission of the non-video message from the sender to the recipient using the presence-based communications session.

83-97. (Canceled)

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Evidence Appendix

None.

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Related Proceedings Appendix

None.